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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,560	06/23/2003	James W. Darrow	CGI-0004	1258
23413	7590	12/27/2004		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002				
			EXAMINER TUCKER, ZACHARY C	
			ART UNIT	PAPER NUMBER

1624

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,560

Applicant(s)

DARROW ET AL.

Examiner

Zachary C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11Aug03, 8Dec03, 19Feb04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to chemical compounds, classified in classes 544 (where "W" is 1,2 and 1,3 and 1,4 diazines), 546 (where "W" is pyridine), and 548 (where "W" is imidazole and pyrazole) and claim 15, drawn to a pharmaceutical composition comprising the compounds, classified in class 514, various subclasses depending on the identity of the active ingredient.
- II. Claims 16-20, drawn to a pharmaceutical composition and methods of treating diseases, classified in class 514, in various subclasses, depending on the identity of the therapeutic agent in the method.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case kinase-implicated conditions, such as cancer are treatable with materially different agents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The requirement is further set forth hereinbelow:

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Claim 1 is generic to a plurality of disclosed patentably distinct species comprising the compound of the working examples. Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species**, even though this requirement is traversed. Related structures will be grouped together for examination purposes.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The basis for the requirement for an election of species arises from the several patentably distinct core groups "W" specified in claim 1.

The examiner has required restriction between compounds and method of use claims. Where applicant elects claims directed to compounds, and a compound claim is subsequently found allowable, withdrawn method of use claims that depend from or otherwise include all the limitations of the allowable compound claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Method of use claims that depend from or otherwise include all the limitations of the patentable compound** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the compound claims and the rejoined method of use claims will be withdrawn, and the rejoined method of use claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected compound claim is found allowable, an otherwise proper restriction requirement

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between compound claims and method of use claims may be maintained. Withdrawn method of use claims that are not commensurate in scope with an allowed compound claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the method of use claims should be amended during prosecution either to maintain dependency on the compound claims or to otherwise include the limitations of the compound claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Information Disclosure Statement

Signed and initialed forms PTO-1449 from the Information Disclosure Statements filed 11 August and 8 December 2003, and 19 February 2004 are enclosed.

The ~~following~~ references authored by Coudert et al, Emelina et al, Zayed et al and Cavalier et al were not in the file, so are lined through on the PTO 1449.

If applicants provide these references, the examiner will gladly consider them.

Conclusion

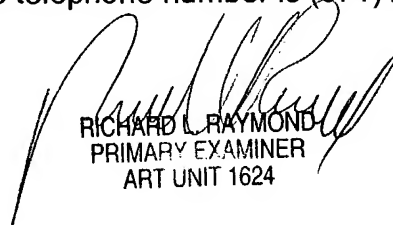
Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Tuesday-Thursday from 6:15am to 2:45pm, Monday from 6:15am to 1:45pm and Friday from 6:15am to 3:45pm (EST). If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mukund Shah, can be reached at (571) 272-0674.

If, after a 24-hour period, Dr. Shah is unreachable, contact the examiner's acting supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (517) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2717.

zt



RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624